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1077 Northern Boulevard
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In re Application of
ERKHOV, Valentin, Sergeevich
U.S. Application No.: 09/673,686
PCT No.: PCT/RU98/00143
International Filing Date: 18 May 1998
Priority Date: 20 April 1998
Attorney's Docket No.: ERKHOV-1 (PCT)
For: METHOD FOR PRODUCING A SPECIFIC
ANTISERUM AGAINST THE UNIVERSAL
TUMOROUS ANTIGEN AND METHOD FOR
DIAGNOSING MALIGNANT TUMOURS USING
SAID ANTISERUM

COMMUNICATION
REGARDING
SUBMISSION UNDER 37
CFR 1.42

This decision is issued in response to the filing of a declaration executed on behalf of deceased inventor Valentin Sergeevich ERKHOV by Galina Mikhailivna ERKHOVA as "Wife and sole heir" to the deceased inventor (treated under 37 CFR 1.42). No petition fee is required.

BACKGROUND

On 18 May 1998, international application PCT/RU98/00143 was filed, which claimed a priority date of 20 April 1998 and which designated the United States. On 28 October 1999, a copy of the international application was communicated to the United States Patent And Trademark Office ("USPTO") by the International Bureau ("IB").

On 19 November 1999, a Demand was filed with the International Preliminary Examining Authority electing the United States. The election was made prior to the expiration of nineteen months from the priority date. As a result, the deadline for payment of the basic national fee was extended to expire thirty months from the priority date, i.e., 20 October 2000.

On 19 October 2000, applicant filed a transmittal letter for entry into the national stage in the United States accompanied by, among other materials, a translation of the international application into English and payment of the basic national fee. The transmittal letter noted that the international application had already been transmitted by the IB.

On 07 November 2000, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) and a Notification Of A Defective Oath Or Declaration (Form PCT/DO/EO/917) indicating that an

oath or declaration in compliance with 37 CFR 1.497 and a surcharge for providing the oath or declaration later than 30 months from the priority date were required.

On 01 December 2000, applicants filed a response that included the \$65 small entity surcharge, a declaration executed on behalf of deceased inventor Valentin Sergeevich ERKHOV by Galina Mikhailivna ERKHOVA as "Wife and sole heir" to the deceased inventor, and supporting documents.

DISCUSSION

37 CFR 1.42 *When the Inventor is Dead*, states, in part:

In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent.

Section 409.01(a) of the Manual of Patent Examining Procedure (MPEP) states that the application can also be executed by "all of the heirs" of the deceased inventor, where no legal representative has been appointed.

The declaration filed on 01 December 2000 is executed on behalf of deceased inventor Valentin Sergeevich ERKHOV by Galina Mikhailivna ERKHOVA as "Wife and sole heir" to the deceased inventor. Based on the assertion in the declaration that Galina Mikhailivna ERKHOVA is the "sole heir" of the deceased inventor, this declaration is acceptable under 37 CFR 1.42.

However, in addition to satisfying 37 CFR 1.42, the declaration must also satisfy the requirements of 37 CFR 1.497(b)(2), which states the following:

(2) If the person making the oath or declaration or any supplemental oath or declaration is not the inventor (§§ 1.42, 1.43, or § 1.47) the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor would have been required to state. If the person signing is the legal representative of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence, and mailing address of the legal representative.

Pursuant to revised 37 CFR 1.497(b)(2), in addition to the residence, citizenship, and post office address of the deceased inventor, the declaration must also provide this information for the signing heir. The declaration filed on 01 December 2000 does not provide all of this information with respect to the signing heir. Specifically, **the declaration does not provide the heir's citizenship. Accordingly, the declaration is not in compliance with 37 CFR 1.497(b)(2).**


CONCLUSION

The declaration filed on 01 December 2000 is **DISMISSED** without prejudice under 37 CFR 1.42.

The declaration cannot, however, be accepted under 37 CFR 1.497. Applicant has **TWO (2) MONTHS** from the mailing date of this decision to submit a declaration that is acceptable under 37 CFR 1.42 and in compliance with 37 CFR 1.497, and specifically, in compliance with 37 CFR 1.497(b)(2)

Extensions of time can be obtained pursuant to 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



Leonard Smith
PCT Legal Examiner
PCT Legal Office

RMR/LS:rmr



Richard M. Ross
PCT Petitions Attorney
PCT Legal Office
Telephone: (703) 308-6155
Facsimile: (703) 308-6459